



PATENT
Attorney Docket No. 018638-04-5010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Glenn McGARRY, *et al.*) Confirmation No. 7173
Application No.: 09/764,782) Group Art Unit: 3693
Filed: January 17, 2001) Examiner: J. Borlinghaus
For: SYSTEM FOR CAPTURING DEAL INFORMATION)

Commissioner for Patents
U.S. Patent and Trademark Office
Alexandria, VA 22314

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the final Office Action issued on August 7, 2008, the period for response extending until November 7, 2008, Applicants request a pre-appeal brief review of the final rejection of claims 26-58. In particular, independent claims 26, 36, and 46 stand finally rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Sandhu (US Pub. No. 2003/0033212) in view of McErlean (US Pat. No. 7,024,462). Applicants respectfully submit that the final Office Action fails to set forth a *prima facie* case of obviousness for the following reasons.

As an initial matter, in determining differences between the prior art and the claims, the question under §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *See* M.P.E.P. §2141.02(I) citing to *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Applicants respectfully submit that the claims and the references are being analyzed in a piecemeal manner.

Applicants have explained this deficiency during an Interview held on 4/2/2008 and again in a response to the previous Office Action filed on 4/4/2008, incorporated herein by reference.

More specifically, the Office acknowledges that the primary reference, Sandhu, fails to teach or suggest routing captured information of one or more deals based on one or more product types of the one or more financial products associated with the one or more deals, wherein the one or more deals are executed trades. To cure at least this deficiency, the Office continues to rely on McErlean as teaching such a feature.

However, McErlean is directed to routing email messages based on tags and has no relation to processing executed trades. As discussed during the Interview of 4/2/2008 and explained in the response filed 4/4/2008, McErlean, at best, only teaches routing email messages based on tags, and the Office Action of January 10, 2008 made no attempt to identify any section of McErlean to support the allegations made in the rejection. In an apparent effort to justify and uphold the previous rejection, the Office now cites to column 1, lines 11-65 of McErlean in the final Office Action to support the allegations made in the previous Office Action of 1/10/2008. Applicants respectfully traverse.

Column 1, lines 11-65 of McErlean currently cited have nothing to do with routing messages based on “tags” as alleged in the final Office Action. In fact, columns 1 and 2 of McErlean describe the prior art, and problems associated thereto, that led to the invention described in McErlean. In column 1, McErlean describes that existing systems route messages using a text analyzer to determine the context of an email message by analyzing the text of the message (e.g., text sequence), categorizing the message based on the analysis (e.g., balance inquiry, request for transfer, interest rate inquiry), and then routing the message to someone who may be best to handle the message. There is no teaching or suggestion of routing captured

information of one or more deals based on one or more product types of the one or more financial products associated with the one or more deals, wherein the one or more deals are executed trades. Accordingly, Sandhu and McErlean are disparate systems with no motivation to combine. However, even if combinable, *in arguendo*, the combination still fails to teach or suggest routing captured information of one or more deals based on one or more product types of the one or more financial products associated with the one or more deals, wherein the one or more deals are executed trades.

In order to make column 1 of McErlean apply to at least the independent claims, the Office is alleging that if a message containing product type information is received in McErlean's system, it will route that message to someone based on the product type contained in the message. However, there is no factual basis for this conclusion. Column 1 of McErlean merely discloses that existing systems classify a message based on text analysis (e.g., frequency or sequence). There simply is no teaching or suggestion that the classification is based on one or more product types of one or more financial products associated with executed trades as recited in independent claims 26, 26, and 46.

MPEP §2143.01(III) specifically states that “[t]he *mere fact* that references *can* be combined or modified *does not render* the resultant combination *obvious* unless the prior art also suggests the desirability of the combination” (citing to *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). Here, neither Sandhu nor McErlean discloses routing captured information of one or more deals based on one or more product types of the one or more financial products associated with the one or more deals, wherein the one or more deals are executed

trades. Accordingly, to state otherwise would be improper hindsight as the systems of Sandhu and McErlean are being modified based on the Applications' own disclosure. Applicants respectfully submit that there is no factual basis to support the modification alleged in the final Office Action in rejecting at least independent claims 26, 36, and 46.

The Office also improperly dismisses the difference between an "execute trade" and a transaction that has not yet taken place based on the allegation that claim 32 recites that there is an "in process" state and a "pending trade authorization" state. Applicants respectfully submit that an executed trade undergoing processing or under pending authorization does not change the fact that the trade has been executed (i.e., both parties have agreed to the trade). Sandhu's system, as explained during the Interview of 4/2/2008 and in the previous response of 4/4/2008, is a front-end trading system that facilitates trading (i.e., matching sellers and buyers). The "transaction" replied upon in the Office Action refers to a transaction that is being structured by the members to be executed. Regardless, even if, *in arguendo*, the "executed trades" are construed as front end processes as that of Sandhu, Applicants respectfully assert that Sandhu and McErlean, even if combined, fail to teach or suggest each and every feature as explained above.

Lastly, Applicants respectfully submit that it is unfair for the Office to continue making blanket conclusions with no citation of support in one Office Action, then providing the support in the next Office Action to make the Office Action final. Moreover, in the present case, the citation relied upon by the Office to justify the previous rejection is to the Background section of McErlean describing known systems (i.e., text analysis for classification of messages) that has

nothing to do with McErlean's invention (i.e., tag-based classification of messages).

In view of the foregoing, Applicants respectfully submit that the final Office Action fails to establish a *prima facie* case of obviousness. Moreover, Sandhu and McErlean, whether taken individually or in combination, fail to teach or suggest all of the features of independent claims 26, 36, and 46 for at least the reasons explained above. Accordingly, dependent claims 27-35, 37-45 and 47-58 are also considered to be allowable over Sandhu and McErlean for at least the reasons explained above. Hence, reconsideration and timely allowance of the pending claims are respectfully requested.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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Dated: 8/27/08

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